

REMARKS

The Office Action of October 15, 2009 was received and carefully reviewed. Claims 1-18 were pending prior to the instant amendment. By this amendment, claims 1-4, 5 and 18 are amended. Consequently, claims 1-18 are currently pending in the instant application. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yudasaka et al. (U.S. Patent Publication No. 2002/0179906, hereinafter “Yudasaka”) in view of Bojkov et al. (U.S. Patent No. 5,947,783, hereinafter “Bojkov”). Yudasaka and Bojkov, however, fail to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, independent claim 1 recites a combination that includes, among other things:

“. . . a gate electrode comprising a chained metal body of nanoparticles over the one of the pair of substrates . . .”

Independent claims 2-4 recite similar features. Support for this aforementioned amended features is found, at least, in paragraphs [0069] and [0070] of the corresponding U.S. Patent Application Publication. At the very least, Yudasaka in view of Bojkov, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in independent claims 1-4.

In addition, on page 3 of the outstanding Office Action, the Examiner asserts that Bojkov discloses “[a] first layer including at least one of silicon nitride and silicon nitride oxide formed on and in direct contact with the gate electrode . . . a gate insulating layer at

least comprising a second layer including silicon oxide over the first layer . . . and a semiconductor layer over the gate insulating layer.” However, upon close review of Bojkov, the reference merely describes “[t]he dielectric, or insulating, material may be comprised of SiO_x , Si_xNy , silicon oxi-nitride, or a metal oxide,” (e.g., see column 3, lines 14 and 15). Accordingly, the recited features of Bojkov do not include a stacked structure of “*a first layer including at least one of silicon nitride and silicon nitride oxide formed on and in direct contact with the gate electrode, a gate insulating layer at least comprising a second layer including silicon oxide over the first layer,*” as recited in claims 1-4 of the subject application. Furthermore, the Examiner purports that item #600 is a semiconductor layer. However, Bojkov denotes item #600 as an anode, not a semiconductor layer. Accordingly, the rejection to, at least, claims 1-10 is not appropriate and should be withdrawn.

Regarding claims 11 and 12, the Examiner alleges that Yudasaka describes “*forming a gate electrode over a substrate having an insulating surface with a droplet discharge method using a composition containing conductive particles . . . Yudasaka para 00183, etc.),*” (e.g., see page 5 of the Office Action). However, when referencing paragraph [0183], etc. of Yudasaka, there is no description about “*forming a gate electrode* over a substrate having an insulating surface with a droplet discharge method using a composition containing conductive particles, as recited in Applicant’s claims. Thus, the cited prior art references fail to disclose or fairly suggest the claimed features of claims 11 and 12, and their dependent claims 13-18.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how Yudasaka in view of Bojkov, whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. *See M.P.E.P. § 2143 (8th ed. 2007).* Second, the Examiner has not shown the

existence of any reasonable probability of success in modifying Yudasaka, the base reference, based on the teachings of Bojkov, the secondary reference, in a manner that could somehow result in the claimed invention. *See id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Yudasaka in a manner that could somehow result in the claimed invention. *See id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. *See id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Yudasaka, taken alone or in combination with Bojkov, can either anticipate or render obvious each and every one of the limitations present in independent claims 11-18, as required by the M.P.E.P. and Federal Circuit jurisprudence.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully

submitted that neither Yudasaka nor Bojkov, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 1-18. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1-4 or 11-12 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1-4 and 11-12. In addition, each of the dependent claims also recites combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent agent at (202) 585-8316.

Respectfully submitted,

NIXON PEABODY, LLP

/Marc W. Butler, Reg. #50,219/
Marc W. Butler
Registration No. 50,219

NIXON PEABODY LLP
CUSTOMER NO.: 22204
401 9th Street, N.W., Suite 900
Washington, DC 20004
Tel: 202-585-8000
Fax: 202-585-8080